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09/901,548

07/09/2001

Hironori Utsugi

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04/07/2003

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/901,548

Applicant(s)

UTSUGI, HIRONORI

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of species (A), figure 5 in Paper No. 6 of 3/11/2003 is acknowledged. As a result of applicant's election, claims 1-4, 6 and 10-14 are examined in this Office action, and claims 5 and 7-9 have been withdrawn from further consideration as being directed to non-elected claims.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

3. The drawings contain twelve sheets of figures 1-15B filed on 7/9/2001 were received by the Office.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In particular, the references "12e" and "16" as shown in figure 3 are not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because the use of the reference "5c" in figure 6 is improper. The reference "5c" should be changed to --50--. See page 8 and figs. 1-2, for example. A proposed drawing correction or corrected drawings are required in reply to

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the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-4, 6, 10-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for use a holder having two supports for supporting a light illuminator wherein only one support is used to attach to the attaching portion of the focusing movable portion. See specification in pages 9 and fig. 5, elements 10 and 20, does not reasonably provide enablement for use a holder having two supports for supporting a light illuminator wherein either support is used to attach to the attaching portion of the focusing movable portion. Applicant should note that the (horizontal) portion of the holder, i.e., the first support, cannot be used to attach to the attaching portion of the focusing movable portion (11). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

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9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 19 is indefinite because the feature thereof "said guide portion can be selected" (line 4) is indefinite. What does applicant mean by the above-mentioned feature?

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 6 and 13-14, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by the prior art described in columns 1-2 and shown in figures 3-4 of the Patent issued to Aikawa (U.S. Patent No. 5,946,133).

The prior art as described in columns 1-2 and shown in figures 3-4 of the Patent issued to Aikawa comprises the elements as follow: 1) a housing for holding a microscope system (2) having an objective lens (9) and an observation tube (7)

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with the housing supporting the microscope and the illuminating system wherein both elements are supported on a stand (3). The mechanism for connecting/attaching the surfaces of the focus mechanism (4) and the housing as provided in column (1) provides the attaching features similar as that recited in the claim. The focus mechanism comprises a movable portion, i.e., the holding case, which is movable in a vertical direction with respect to the fixed portion (27). See details as provided in column 2. The housing supporting the microscope and the illuminating system comprises 1) a first holder having a horizontal section disposed around the optical axis or the observation path and also having a section attached to the attaching surface of the focus mechanism; and 2) a second holder having a section located outside the observation path and is used to support the switch of the illuminator (10).

13. Claims 1, 10 and 12-14, as best as understood, are rejected under 35

U.S.C. 102(b) as being anticipated by Biber (U.S. patent No. 6,072,622).

Biber discloses a microscope having an illuminating system. The device as described in columns 3-4 and shown in figure 1 comprises a housing (1) for holding an observation tube (3) on an upper side of the housing, and also for holding a focus mechanism (2) on a lower side of the housing. The focus housing comprises a movable section supporting an illuminating system which comprises a fiber or alternative a light source; and a guide portion having attaching surfaces for engaging with the surfaces of the guides (13a, 13b) provided by the housing

(1). The guide portion of the system comprises a drive apparatus which can be a

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manual mechanism or a motor mechanism having a plurality of gear elements wherein in one gear element acts as a middle gear. The mechanism for connecting/attaching the surfaces of the sections constituting the focus mechanism and the guide shafts (13) of the housing (1) as shown in figure 1 are considered as the ones meeting the attaching features recited in the claim. The housing supporting the microscope and the focusing housing comprises 1) a first holder having a horizontal section disposed around the optical axis or the observation path and also having a section attached to the attaching surface of the focus mechanism; and 2) a second holder in the form of the guide shafts located outside the observation path and is used to support the focus housing supporting the illuminating system.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as described in columns 1-2 and shown in figures 3-4 of the Patent issued to Aikawa (U.S. Patent No. 5,946,133).

The prior art as described in columns 1-2 and shown in figures 3-4 of the Patent issued to Aikawa comprises the elements as follow: 1) a housing for holding a

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illuminating system (10,12); and 2) a focusing mechanism (4) in contact with the housing supporting the microscope and the illuminating system wherein both elements are supported on a stand (3). The mechanism for connecting/attaching the surfaces of the focus mechanism (4) and the housing as provided in column (1) provides the attaching features similar as that recited in the claim. It is noted that the attachment is made via the use of three screws (17), not four screws as recited in the present claim 4. However, the use of three or four screws for attaching /connecting two elements together is considered as an obvious matter within the level of one skilled in the art for the purpose of improving the stability of the connection. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use four screws for connection to meet a particular design.

***Allowable Subject Matter***

16. Claims 2-3 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. The following is an examiner's statement of reasons for allowance:

First, the device as claimed in present claim 2/1 is patentable with respect to the cited art by the limitations relating to the holder for supporting the illuminator and the microscope wherein the connection between the illuminator and the holder comprises a round dovetail. While the use of dovetail for attaching an element to another element is known to one skilled in the art as can be seen in the system provided by Hasegawa (Patent 5,270,855); however, the prior art does not



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disclose the use of a holder having a dovetail for supporting an illuminator wherein the holder also supports an observation system and an objective lens which holder comprises the features thereof "said holder comprises...attaching portion" recited on last 9 lines of present claim 1.

Second, the device as recited in present claim 11/10/1 is patentable with respect to the applied art by the limitations relating to the structure of the focus mechanism recited in the features thereof "said guide portion...focusing handle" (lines 2-6) wherein the focus mechanism is used in combination with a holder holding an observation system and an objective lens which holder comprises the features thereof "said holder comprises...attaching portion" recited on last 9 lines of present claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***C nclusion***

18. The prior art made of record and not relied upon is considered pertinent to

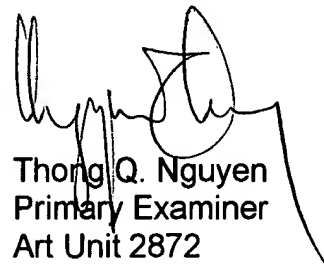
applicant's disclosure. The additional references are cited as of interest in that each

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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April 2, 2003